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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,804	12/07/2005	Christof Maisch	LA-7688-102/10512640	1047
167 7590 12/09/2008 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071				
EXAMINER				
WINDELL, MARK R				
ART UNIT		PAPER NUMBER		
3635				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/559,804

**Applicant(s)**

MAISCH ET AL.

**Examiner**

MARK R. WENDELL

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19, 21-22, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, Jr. (US 3271920) in view of Chicago (WO 97/12101). Regarding claims 1 and 2, Downing illustrates in Figure 1 a profile rail for the support of panel-like elements (7), comprising:

- A base body (10) that is formed at least regionally as a T section and that includes an elongate web (16) as well as a bottom chord (19), which is arranged along a longitudinal edge of the web (16) and includes two bottom chord sections (21, 22), each of which extend from the web (16) substantially in opposite directions, with the bottom chord (19) comprising:
  - A bent-over portion of the web (16) wherein a plurality of apertures (see apertures in 16 in Figure 1) are formed in the web (16), at least one of the bottom chord sections (21) comprises material sections of the web (16) folded out of the apertures and the web (16) is essentially made in one layer over its total area.

Downing does not illustrate a screening strip disposed on the bottom chord; however Chicago illustrates in Figure 2 a screening strip (see bottom edge) on the bottom chord. It would have been obvious to one having ordinary skill in the art at the time of invention to include a screening strip to the bottom chord in order to provide a rigid stabilizer or for safety purposes.

Regarding claim 3, Downing illustrates in Figure 1 both bottom chord sections (21 and 22) respectively alternating and comprising regionally material sections of the web folded out of the apertures (22) and one-piece bent-over portions of the web (21) adjoining them, with each one-piece bent-over portion of the one bottom chord section lying opposite to a material section of the other bottom chord section.

Regarding claims 4 and 5, Downing illustrates in Figure 4 the apertures, which are rectangular, each having a straight edge (bottom edge if view in Figure 1) extending parallel to the longitudinal edge of the web (16).

Regarding claims 6 and 7, Downing illustrates in Figure 1 the outer edges of the two bottom chord sections (21 and 22) extending parallel to one another and the chord sections are substantially the same width.

Regarding claim 8, Downing illustrates in Figure 1 the bottom chord (19) and the web (16) substantially perpendicular to one another.

Regarding claims 9 and 12, it is described above what is disclosed by Downing in view of Chicago; however the references do not distinctly give measurements for the radius of the bent-over portion or the thickness of the web and chords. The applicant fails to provide criticality for the distinct measurements given within the claims and it would have been obvious to one having ordinary skill in the art at the time of invention to have the specific measurements for the radius, web and chord since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F. 2d 272, 205 USPQ 215). The examiner also notes that the variability of the actual specific measurement values within the claim lends credence to the fact that the specific dimensions are not in fact critical to the viability of the invention.

Regarding claim 10, Downing illustrates in Figure 1 the base body made from one, seamless strip of material. Downing also mentions in Column 2 the structure made from section metal which is a form of sheet metal (which by definition is metal formed into thin, flat sections).

Regarding claim 11, Downing illustrates in Figure 1 the web (16) being flat.

Regarding claim 13, Chicago illustrates in Figure 2 the screening strips engaging the longitudinal edges of the bottom chord members.

Regarding claim 14, Downing illustrates in Figure 1 a top chord (10-14) provided at the longitudinal edge of the web opposite the bottom chord.

Regarding claim 15, Downing illustrates in Figure 3 the top chord (10-14) coupled to fastening elements (41 and 33).

Regarding claim 16, the top chord (10-14) of Downing is a hollow section as can be seen in Figures 1 and 3.

Regarding claim 17, Downing illustrates in Figure 1 the top chord (10-14) disposed opposite the bottom chord.

Regarding claim 18, Downing illustrates in Figure 1 the top chord (10-14) having a longitudinal edge (12) connected to the web (16).

Regarding claim 19, the references do not distinctly claim the top chord being connected to the web via stitching. However, the web and top chord are connected as described above. Various methods of attaching metal objects together are well known within the art including stitching, which is generally done with wire staples.

Regarding claims 21 and 22, Downing illustrates in Figure 1 the apertures having the same width in the longitudinal direction of the web (16). Downing also illustrates the

apertures in the longitudinal direction of the web having the same width as the material sections (22).

Regarding claims 26-32, Downing in view of Chicago illustrates and describes the structure of the invention and the method of producing the structure would be obvious given this structure.

Claims 20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, Jr. (US 3271920) in view of Chicago (WO 97/12101) as applied to claim 1 above, and further in view of Lalonde et al. (US 5761868). It is described above what is disclosed by Downing in view of Chicago, however regarding claims 20 and 23-24 the references do not teach additional fastening apertures, or reinforcement beads (18), formed in the web. LaLonde illustrates in Figure 1 additional fastening apertures (apertures on the side of 18). Downing, Chicago and LaLonde all refer to profile connector rails and it would have been obvious to one having ordinary skill in the art at the time of invention to include additional apertures, or reinforcement beads in between the apertures, in the web of Downing in view of Chicago in order to facilitate more interconnecting support members for utilities.

Regarding claim 25, neither Downing, Chicago nor LaLonde teach two reinforcement elements disposed between two apertures in the web. However, it would have been obvious to one having ordinary skill in the art at the time of invention to have additional

reinforcement elements or beads between two apertures in the web since it has been held that rearranging parts of an invention (without compromising the structural integrity) involves only routine skill in the art (*In re Japikse*, 86 USPQ 70). The examiner further notes that adding additional apertures or beads would be obvious based on the size of the rail that is necessary.

### ***Response to Arguments***

Applicant's arguments filed 8/28/2008 have been fully considered but they are not persuasive. The examiner notes that the main argument from the applicant is that the prior art reference does not show the invention being utilized "for the insertion assembly of the ceiling panels for grid ceilings." The examiner notes that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (*Ex parte Masham*, 2 USPQ 2d 1647 (1987)). The examiner also notes that the "limitation" is within the preamble of the claim and has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause (*Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)).

Also, the examiner notes that many arguments exist regarding the usage of the apparatus and the presence of "kinking points." There is no claim language that points



to "kinking points" and there function or importance. It should be noted that it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable (Constant v. Advanced Micro-Devices Inc., 7 USPQ 2d 1064).

Lastly, the examiner notes that Downing teaches in column 6, "other modes of applying the principle of this invention may be employed instead of those specifically set forth." The principle of the invention is to find an alternate, better method of holding panels together, which is the principle of the instant application and the Chicago reference which is used in conjunction with the Downing reference for the rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK R. WENDELL whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/M. R. W./  
Examiner, Art Unit 3635  
November 24, 2008